



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,840	03/12/1999	SCOTT EVANS	EVA-001	7636

7590 08/12/2003  
JOHN F WOOD  
WARD & OLIVA  
708 THIRD AVE  
NEW YORK, NY 10017

EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/267,840

Applicant(s)

EVANS, SCOTT

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 21-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation of accessing said transaction community without system enrollment cannot be found in the original specification, claims or drawings. Page 33, lines 9-12 of the applicant's specification disclose that a new debtor is invited to join the transaction community using a new customer service option. Page 36, lines 5-16 of the applicant's specification disclose that the user must enter a customer ID and receive proper authentication. Page 38, lines 10 and 11 of the applicant's specification discloses that an account number verification will be requested from the customer. Pages 54, 58 and 70 of the applicant's specification disclose that the debtor must login to the system using a User ID and a

password to access his or her account. It is clear from these examples that an account has been set up for the user and therefore the user is enrolled in the system. If the applicant means that the user does not perform the enrollment, then the claims should be amended to state this. The claims are rejected below as if they were claiming that the biller enrolls the debtor.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 23, 24, 29, 30, 31, 32, 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al, both of record. Lamm discloses sending a bill over the Internet, see col. 5, line 21 and col. 11, lines 60-62, a bill identification

number is disclosed in col. 10, lines 54-57 and col. 13, lines 22-26, the bill identification number is an authorization code which is included in the payment instructions back to the biller, see col. 15, lines 46-49. Col. 7, lines disclose that the billing party may deal directly with the bill payers. Including advertising material with the bill is disclosed in col. 14, lines 61-66. Payment by credit card authorization is disclosed in col. 16, lines 44-47. Lamm does not disclose enrollment of new accounts by the biller. Remington et al disclose an electronic bill presentment and payment system in which the biller enters all account information for new accounts, see col. 5, lines 44-55, col. 7, lines 50-60 and col. 10, lines 3-15. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Remington et al to have the biller in Lamm control the information that establishes new accounts.

Claims 22, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Bednar et al. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except payment by electronic check. Bednar et al show a system for paying bills with the electronic check shown in Fig. 5. It

would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Bednar et al to modify the device of Lamm to allow payment by electronic check to give the bill payers more ways to pay the bills.

Claims 25, 26, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Hilt et al. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except payment of the bills through the mail. Hilt et al disclose paying bills in col. 13, lines 48-50 paying bills either electronically or through the mail. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Hilt et al to modify the device of Lamm to allow payment through the mail to give the bill payers more ways to pay the bills.

Claims 27, 28, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm in view of Remington et al as applied to claim 21 above in further view of Ziarno. Lamm, as modified by Remington et al, shows all the features of the applicant's claimed invention except the means to allow the bill payor to make political or charitable contributions. Ziarno discloses a method for making political or charitable contributions, see col. 5, line 55, over the Internet, see col. 11, line 26, using electronic funds transfer, see col. 10, line 2. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Ziarno to provide the device of Lamm with

means to allow the bill payor to make political or charitable contributions over the Internet as a further service to the bill payor.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
F. J. BARTUSKA  
PRIMARY EXAMINER 8/9/03